

STATEMENT OF FACTS

This application was originally filed on October 22, 2003.

A first Office action on the merits was issued on October 28, 2004, rejecting the claims under 35 U.S.C. § 103(a) over a single reference to Causton. A response to this rejection was filed on February 28, 2005.

A second non-final Office action was issued on June 10, 2005, making a new ground of rejection under 35 U.S.C. § 103(a) over Ozaki et al. A response to this rejection was filed on September 6, 2005.

A third Office action was issued on November 30, 2005, stating that the Office action was final. Because this Office action improperly failed to address all of the pending claims (in particular, failed to treat claims 49-51), it was reissued on January 10, 2006. The Office action made new grounds of rejection under 35 U.S.C. § 103(a) over Kaufman in view of Rutz and over Kaufman in view of Ozaki et al. This Office action indicated on the Office Action Summary that it was non-final. However, paragraph 6 of the Office action indicated that the Office action was final, and that new grounds of rejection were due to Applicant's amendment. A response to this rejection was filed on April 10, 2006. The response pointed out that the replacement Office action again improperly failed to address all of the pending claims (this time, claim 51 was omitted). In an Interview Summary Record dated May 23, 2006, reporting a telephonic interview that occurred on May 9, 2006, the Examiner stated:

Applicant called to question status of pending case. The Examiner acknowledged that the case is non-final and stated that PALM would be corrected to reflect non-final status. The Examiner also pointed out that pending claim 51 should be grouped in paragraph 4 of the pending office action as rejected.

A fourth Office action was issued on October 19, 2006. This Office action made a new ground of rejection of claim 49 under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the enablement requirement. Claim 49 was added in the response filed September 6, 2005, and was not amended in the response filed April 10, 2006. Accordingly, the new ground of rejection could not have been necessitated by Applicants' amendment to claim 49. Nevertheless, the Office action was made final. The Office action also made new grounds of rejection of claim 30 under 35 U.S.C. § 112, second paragraph, and of claims 20-30, 34-38, 40, and 48-49 under 35 U.S.C. § 103(a) over Ozaki et al. alone, and of claims 39, 50, and 51 over Ozaki et al. in view of Rutz et al. A response to this Office action was filed on February 20, 2007.

An Advisory Action was issued March 15, 2007, indicating that the amendments filed on February 20, 2007 would be entered on the filing of an appeal, but that the amendments did not place the application into condition for allowance.

A Request for Continued Examination was filed on April 19, 2007, requesting that the amendments filed on April 10, 2006 not be entered.

A fifth, non-final Office action was issued on June 27, 2007. The rejection of claims 20-30, 34-38, 40, and 48-49 under 35 U.S.C. § 103(a) over Ozaki et al. alone and the rejection of claims 39, 50, and 51 under 35 U.S.C. § 103(a) over Ozaki et al. in view of Rutz were repeated. A response to this Office action was filed October 24, 2007.

A sixth Office action was issued on January 24, 2008. This Office action made a new ground of rejection of claims 20-30, 34-40, and 48-49 under 35 U.S.C. § 103(a) over Ozaki et al. in view of Rutz (previously, these claims, except for claim

39, had been rejected over Ozaki et al. alone). The Office action also made a new ground of rejection of claims 20-25, 30, 34-40, and 48-49 under 35 U.S.C. § 103(a) over Rutz in view of Kondo. The Office action stated in paragraph 7 that it was made final, alleging that Applicant's amendment necessitated the new grounds of rejection. A response to this Office action was filed on June 23, 2008. In this response, no amendments were made to the claims, specification, or drawings of the application in this response and no request for the withdrawal of finality of the Office action dated January 24, 2008 was made by Applicants. However, reconsideration of the rejections was requested, and a declaration under 37 C.F.R. § 1.132 was presented.

A seventh Office action was issued on July 16, 2008. In paragraph 1 of the Office action, the Examiner states:

Responsive to the amendment filed 23 June 2008, no amendments are made to the claims.

Office action dated July 16, 2008 at paragraph 1. In paragraph 2 of the Office action, the Examiner states:

Responsive to the amendment filed 23 June 2008, the finality of the Office action of 24 January 2008 is withdrawn. New grounds for rejection are presented.

Office action dated July 16, 2008 at paragraph 2. The Office action repeated the rejection of claims 20-25, 30, 34-40, and 48-49 under 35 U.S.C. § 103(a) over Rutz in view of Kondo. See Office action dated July 16, 2008 at paragraph 4. However, the Examiner made a new ground of rejection of claims 20-30, 34-38, 40, 48, and 49 under 35 U.S.C. § 103(a) over Ozaki et al. alone. The Examiner also made another new ground of rejection of claim 39 under 35 U.S.C. § 103(a) over Ozaki et al., further in view of Ferguson. The conclusion of the Office action states that:

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, THIS ACTION IS MADE FINAL. See MPEP § 706.07(a).

Office action dated July 16, 2008 at page 15. Ozaki et al. has been of record in this application since the Office action dated June 10, 2005, and in fact had been previously relied upon by the Examiner in a number of previous Office actions, as noted above. Ferguson et al. was cited for the first time by the Examiner in the Office action dated July 16, 2008. It was not cited by Applicants in an Information Disclosure Statement.

STATEMENT OF RELIEF REQUESTED

Petitioner respectfully requests that the finality of the Office action dated July 16, 2008 be withdrawn because, based upon the facts above, finality is premature for the reasons given below.

REMARKS

Petitioner respectfully submits that the MPEP does not permit the Office action of July 16, 2008 to be made final. To the contrary, Petitioner respectfully submits that the MPEP requires that the Office action be made non-final. MPEP § 706.07(a), cited by the Examiner in making final the July 16, 2008 Office action, states, in pertinent part:

Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims, nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p). Where information is submitted in an information disclosure statement during the period set forth in 37 CFR 1.97(c) with a fee, the examiner may use the information submitted, e.g., a printed publication or evidence of public use, and make the next Office action final whether or not the claims have been amended,

provided that no other new ground of rejection which was not necessitated by amendment to the claims is introduced by the examiner. See MPEP § 609.04(b). Furthermore, a second or any subsequent action on the merits in any application or patent undergoing reexamination proceedings will not be made final if it includes a rejection, on newly cited art, other than information submitted in an information disclosure statement filed under 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p), of any claim not amended by applicant or patent owner in spite of the fact that other claims may have been amended to require newly cited art. Where information is submitted in a reply to a requirement under 37 CFR 1.105, the examiner may NOT make the next Office action relying on that art final unless all instances of the application of such art are necessitated by amendment.

MPEP § 706.07(a) (emphasis added).

Nowhere does this section of the MPEP contain any statement that would permit the Examiner to make final an Office action containing a new ground of rejection where (1) Applicant did not amend the claims at all, and (2) Applicant did not cite the information forming the basis of the new ground of rejection in an IDS filed under 37 C.F.R. § 1.97(c). This is true irrespective of whether finality of a previous Office action was withdrawn.

In the present application, the Office action of July 16, 2008 acknowledges that no amendment was made to the claims in the response filed on June 23, 2008. A review of the record of IDS's filed by Applicants in this application makes clear that neither Ozaki et al. nor Ferguson et al. were cited by Applicants in an IDS filed under 37 C.F.R. § 1.97(c). Accordingly, the requirements of MPEP § 706.07(a) for making final the July 16, 2008 Office action have not been met. Petitioner submits that, as a result, such finality is improper and should be withdrawn.

Petitioner also submits that it is inappropriate for the Examiner to withdraw finality of the Office action dated January 24, 2008, apparently in an attempt to make new grounds of rejection, and then make the Office action containing the new

grounds of rejection final, as appears to have been done here. MPEP § 706.07(e) describes the situations where the Examiner can, on his own, withdraw finality of an Office action. This section states, in pertinent part:

Once a final rejection that is not premature has been entered in an application/reexamination proceeding, it should not be withdrawn at the applicant's or patent owner's request except on a showing under 37 CFR 1.116(b). Further amendment or argument will be considered in certain instances. An amendment that will place the application either in condition for allowance or in better form for appeal may be admitted. Also, amendments complying with objections or requirements as to form are to be permitted after final action in accordance with 37 CFR 1.116(a).

The examiner may withdraw the rejection of finally rejected claims. If new facts or reasons are presented such as to convince the examiner that the previously rejected claims are in fact allowable or patentable in the case of reexamination, then the final rejection should be withdrawn. Occasionally, the finality of a rejection may be withdrawn in order to apply a new ground of rejection.

Although it is permissible to withdraw a final rejection for the purpose of entering a new ground of rejection, this practice is to be limited to situations where a new reference either fully meets at least one claim or meets it except for differences which are shown to be completely obvious. Normally, the previous rejection should be withdrawn with respect to the claim or claims involved. >See MPEP § 1207.03 for a discussion of what may constitute a new ground of rejection.<

The practice should not be used for application of subsidiary references, or of cumulative references, or of references which are merely considered to be better than those of record.

When a final rejection is withdrawn, all amendments filed after the final rejection are ordinarily entered.

MPEP § 706.07(e).

This section of the MPEP does not provide the examiner with the authority to make the next action final simply because the finality of a previous Office action has been withdrawn. Petitioner has been unable to locate any other portion of the MPEP

which provides such authority. To the contrary, MPEP § 706.07(d), which provides for withdrawal of premature final rejections, states, in pertinent part:

>Once the finality of the Office action has been withdrawn, the next Office action may be made final if the conditions set forth in MPEP § 706.07(a) are met.<

MPEP § 706.07(d) (emphasis added). As Petitioner has already established above, the conditions set forth in MPEP § 706.07(a) have not been met. As a result, not only does the MPEP fail to support what the Examiner has done, it requires that the July 16, 2008 Office action be non-final. By making this Office action final, the U.S. PTO has failed to abide by the procedures that it sets for itself.

In addition to failing to follow its own procedures, making the July 16, 2008 Office action final under the conditions described herein is not supported by sound public policy. Allowing Examiners to make an Office action final because they have decided, *sua sponte*, to withdraw finality in some previous Office action creates a situation ripe for abuse. In effect, such a policy would allow patent examiners to ambush patent applicants with new grounds of rejection after a final rejection has been issued by simply withdrawing finality of the previous Office action. Then, should the patent applicant attempt to address the new ground of rejection, the Examiner can refuse to enter any amendment or declaration, citing 36 C.F.R. § 1.116(b).

For at least these reasons, Petitioner respectfully submits that the finality of the July 16, 2008 Office action is premature, and should be withdrawn, as requested above.

Respectfully submitted,

BUCHANAN INGERSOLL & ROONEY PC

Date: August 5, 2008

By:



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Patent
Attorney Docket No. 1003301-000054

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of) **MAIL STOP PETITIONS**
Mikhail Kejzelman et al.)
Application No.: 10/689,656) Group Art Unit: 1793
Filing Date: October 22, 2003) Examiner: CHRISTOPHER S.
Title: METHOD OF PREPARING IRON-) KESSLER
BASED COMPONENTS) Confirmation No.: 6495
)
)

AMENDMENT/REPLY TRANSMITTAL LETTER

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Enclosed is a reply for the above-identified patent application.

- A Petition for Extension of Time is enclosed.
- _____ Terminal Disclaimer(s) and the \$ 65 \$ 130 fee per Disclaimer due under 37 C.F.R. § 1.20(d) are enclosed.
- Also enclosed: Petition To Withdraw Premature Finality of Rejection Under 37 C.F.R. § 1.181
- Small entity status is hereby claimed.
- Applicant(s) requests continued examination under 37 C.F.R. § 1.114 and enclose the \$ 405 \$ 810 fee due under 37 C.F.R. § 1.17(e).
- Applicant(s) requests that any previously unentered after final amendments not be entered. Continued examination is requested based on the enclosed documents identified above.
- Applicant(s) previously submitted _____ on _____ for which continued examination is requested.
- Applicant(s) requests suspension of action by the Office until at least _____, which does not exceed three months from the filing of this RCE, in accordance with 37 C.F.R. § 1.103(c). The required fee under 37 C.F.R. § 1.17(i) is enclosed.
- A Request for Entry and Consideration of Submission under 37 C.F.R. § 1.129(a) (1809/2809) is also enclosed.

- No additional claim fee is required.
- An additional claim fee is required, and is calculated as shown below:

AMENDED CLAIMS					
	No. of Claims	Highest No. of Claims Previously Paid For	Extra Claims	Rate	Additional Fee
Total Claims	0	20	0	x \$ 50 (1202)	\$ 0
Independent Claims	0	3	0	x \$ 210 (1201)	\$ 0
<input type="checkbox"/> If Amendment adds multiple dependent claims, add \$ 370 (1203)					\$ 0
Total Claim Amendment Fee					\$ 0
<input type="checkbox"/> Small Entity Status claimed - subtract 50% of Total Claim Amendment Fee					0
TOTAL ADDITIONAL CLAIM FEE DUE FOR THIS AMENDMENT					\$ 0

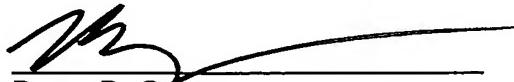
- Charge _____ to Deposit Account No. 02-4800 for the fee due.
- A check in the amount of _____ is enclosed for the fee due.
- Charge _____ to credit card for the fee due. Form PTO-2038 is attached.
- The Director is hereby authorized to charge any appropriate fees under 37 C.F.R. §§ 1.16, 1.17 and 1.20(d) and 1.21 that may be required by this paper, and to credit any overpayment, to Deposit Account No. 02-4800. This paper is submitted in duplicate.

Respectfully submitted,

BUCHANAN INGERSOLL & ROONEY PC

Date August 5, 2008

By:



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